

REMARKS

The Applicant has received and reviewed the Final Official Action dated 15 November 2006 (hereinafter, the "Action"), and submits this paper as a response to the Final Action with a request for continued examination (RCE). The Applicant requests favorable consideration of this response at the earliest convenience of the Office.

As stated in Paragraph 2 on Page 2 of the Action, claims 1-14 and 22-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,329,578 to Brennan, et al. (hereinafter, "Brennan"), in view of U.S. Patent No. 6,014,435 to Rosen (hereinafter, "Rosen"), in view of U.S. Patent No. 5,563,939 to La Porta, et al. (hereinafter, "La Porta"), in view of U.S. Patent No. 5,802,157 to Clarke, et al. (hereinafter, "Clarke"), and further in view of U.S. Patent No. 6,871,082 to Cox, et al (hereinafter, "Cox"). The Applicant respectfully traverses these rejections.

Claims 1-7 and 9-10

Turning first to **independent claim 1**, without conceding the propriety of the stated rejection and solely to advance the prosecution of this application, the Applicant has revised claim 1 to clarify further features of the method. For convenience, the Applicant reproduces here part of the revisions to claim 1:

enabling the subscriber to select special feature codes and request that outgoing communications that relate to the special feature codes, and that originate from the calling line identification number be blocked;

.

activating the outgoing call blocking service at a first pre-set time;
de-activating the outgoing call blocking service at a second pre-set time;

The Applicant submits that the revisions to claim 1 are fully supported under 35 U.S.C. § 112, 1st paragraph, by the originally-filed specification, at least by page 12, line 25 through page 13, line 4 thereof.

Turning to the cited art, the Applicant agrees with the assessment on Page 3 of the Action that Brennan does not disclose enabling the subscriber to request that outgoing communications that relate to special feature codes, and that originate from the calling line identification number be blocked. Neither La Porta, Clarke, nor Cox disclose this recitation. The Applicant also agrees with the assessment on Page 4 of the Action that neither Brennan, nor La Porta, disclose activating the outgoing call blocking service at a first pre-set time and de-activating the outgoing call blocking service at a second pre-set time. Further, Rosen and Cox fail to disclose this recitation. Cox pertains generally to a telephone call management system and method. Accordingly, the Action cited Rosen and Clark for these teachings.

Rosen generally discloses defeating 1-900 calls or other selected calls to prevent children from making them. (Col. 1, lines 19-29). Clarke generally discloses a method of controlling outgoing telephone calls during a selected time period by having a user input a list of authorized outgoing numbers. (Fig. 12). The Applicant submits there is no motivation to combine the time control feature of Clarke with the parental control feature of Rosen.

“The PTO bears the burden of establishing a case of *prima facie* obviousness.” *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, the Examiner must present evidence showing the following three criteria are met: (1) there must be some suggestion or motivation to modify the reference or combine reference teachings; (2) there must be a reasonable expectation of success;

and (3) the prior art references must teach or suggest all claim limitations. MPEP §2143. “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.” *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, a *prima facie* case of obviousness has not been established because there has been no showing of any suggestion or motivation to combine the teachings of the cited references. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Furthermore, the Applicant respectfully submits that to selectively choose certain teachings of either reference and combine those teachings with the other reference would involve impermissible hindsight analysis. The Federal Circuit has cautioned that when analyzing the patentability of claims pursuant to 35 U.S.C. § 103(a), the phrase “at the time the invention was made” is the statutory phrase “that guards against entry into the tempting but forbidden zone of hindsight.” *In re Dembiczak*, 175 F.3d 994, 998, 50 USPQ2d 1614 (Fed. Cir. 1999) (quotation marks omitted). “[T]he best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999); citing *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998).

Clarke fails to teach or suggest “enabling the subscriber to select special feature codes,” but instead creates an authorized calling list based on inputting authorized numbers. For example, a subscriber using the Clarke invention would experience great difficulty in attempting to limit all long distance outgoing calls from a calling location because Clarke does not provide a means for selectively deleting numbers. Under Clarke, the subscriber would have to enter all local calls into the authorized list to effectively restrict access to only long distance outgoing calls.

The Action cites Rosen as teaching the above recitation provided by the Applicant. However, there is no motivation to combine Rosen and Clarke. Further, such a combination may not use impermissible hindsight. Therefore, any motivation to combine the cited references must be provided by the references themselves. Clarke clearly does not suggest any other means for generating a calling list to restrict outgoing calls during a specified time frame. Clarke is concerned with limiting a phone to a small number of calls, each number being inputted manually into an authorized calling list. Rosen does not suggest or provide any motivation to limit the calling defeat system to specified time frames during the day. Rosen presumes the outgoing calls will be blocked whenever unauthorized calling numbers are present in the apparatus. Further, the focus of Rosen involves DTMF character manipulation used to block outgoing calls from the unauthorized list.

Based on at least the foregoing, the Applicant submits that Brennan, Rosen, La Porta, Clarke, and Cox do not support a § 103 rejection of claim 1, and requests reconsideration and withdrawal of the § 103 rejection of claim 1.

Claims 2-7 and 9-10 depend from claim 1 and stand rejected on similar grounds. Accordingly, the above comments directed to claim 1 apply equally to claims 2-7 and 9-

10. For sake of brevity, only a portion of the dependant claims are discussed in further detail below.

The Applicant's claim 2 recites "wherein the special feature code is a star-feature code." The Action points to Rosen column 2, lines 31-43 and columns 2-3 lines 67-15 as teaching the recitation of claim 2. The Applicant respectfully submits that Rosen fails to teach or suggest this recitation. The referenced text from Rosen teaches a call defeat system that adds DTMF characters, "such as pound (#) or star (*) key" to block the call. (Col 2, line 39). In other words, Rosen is not blocking calls that include a star (*) in the number, such as "*69" calls, but rather using this character to force the caller to dial a number that cannot be interpreted by the telephone company central facility. (Col 3, line 6-9). Therefore, Rosen fails to teach or suggest "wherein the special feature code is a star-feature code" as recited by The Applicant's claim 2.

The Applicant's claim 3 recites "wherein the special feature code relates to conference call capabilities." The Action points to Rosen column 1, lines 19-29 as teaching the recitation of claim 3. The Applicant respectfully submits that Rosen fails to teach or suggest blocking conference call capabilities in the cited portion of Rosen, or anywhere in Rosen for that matter. Further, blocking conference calls is unlike blocking a 1-900 call as taught by Rosen because a conference call does not include specific number types (e.g., 1-900), but may include any number, even a local number. Therefore, applying Rosen, a caller could create a conference call between any numbers that were not on an unauthorized list. Therefore, Rosen fails to teach or suggest "wherein the special feature code relates to conference call capabilities" as recited by The Applicant's claim 3.

Based on the foregoing bases, the Applicant thus requests reconsideration and withdrawal of the § 103 rejections of claims 2-7 and 9-10.

Claims 11-14

Turning now to **independent claim 11**, the Applicant reproduces here a portion of claim 11:

prompting a subscriber to the outgoing call blocking service to provide data concerning outgoing calls to be blocked;

.

enabling the subscriber to prohibit calls that relate to special feature codes from being placed from the calling line, wherein at least one of the special features is a star feature code that relates to conference calling capabilities;

Turning to the cited art as applied in the Action, Paragraph 8 on Page 6 of the Action applied Rosen to “conference calling capabilities”, as recited in claim 11. The Action cited column 1, lines 19-29 of Rosen, which relates to calls directed to 900 number destinations. The Applicant respectfully submits that the 900 numbers referred to by Rosen neither teach nor suggest “conference calling capabilities”, as recited in claim 11.

Additionally, there is no motivation to combine the teachings of Rosen and Clarke and such a combination may not use impermissible hindsight, thus the same reasoning as applied to claim 1 above also applies to claim 11. There is no motivation to combine the cited references in Rosen, Clarke, or any other cited reference to combine the teachings of Brennan, Rosen, La Porta, Clarke, and Cox.

Based on at least the foregoing, the Applicant submits that Brennan, Rosen, La Porta, Clarke, and Cox do not support a § 103 rejection of claim 11, and requests reconsideration and withdrawal of the § 103 rejection of claim 11.

Claims 12-14 depend from claim 11 and stand rejected on similar grounds. Accordingly, the above comments directed to claim 11 apply equally to claims 12-14. The Applicant thus requests reconsideration and withdrawal of the § 103 rejections of claims 12-14.

Claims 22-24

Turning now to **independent claim 22**, the Applicant reproduces here a portion of claim 22:

a storage device for storing data concerning outgoing calls to be blocked, and further for storing at least one pre-set time period over which the outgoing call blocking service is to be activated or de-activated, the time period being defined by at least one pre-set time or at least one pre-set day;

. . . .

prohibit calls that relate to special feature codes from being placed from the calling line, wherein at least one of the special features is a star feature code that relates to conference calling capabilities;

Turning to the cited art, the comments directed to claim 11 above regarding Brennan, Rosen, La Porta, Clarke, and Cox apply equally to claim 22. Based on at least the foregoing, the Applicant submits that Brennan, Rosen, La Porta, Clarke, and Cox do not support a § 103 rejection of claim 22. The Applicant thus requests reconsideration and withdrawal of the § 103 rejection of claim 22.

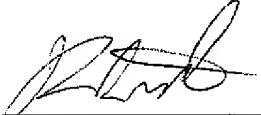
Claims 23-24 depend from claim 22 and stand rejected on similar grounds. Accordingly, the above comments directed to claim 22 apply equally to claims 23-24. The Applicant thus requests reconsideration and withdrawal of the § 103 rejections of claims 23-24.

Conclusion

The Applicant requests reconsideration and withdrawal of the § 103 rejections favorable action of claims 1-14 and 22-24. If any issue remains unresolved that would prevent favorable action on this case, the Office is requested to contact the undersigned to resolve the issue.

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Respectfully submitted,

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